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OFFICE OF PETITIONS

In re Application of :
Relyea et al. : DECISION DISMISSING
Application No. 10/694,080 : PETITION
Filed: 24 October, 2003 :
Attorney Docket No. MSI-1779US :

This is a decision on the petition under 37 C.F.R. § 1.183, filed on 30 August, 2004, requesting waiver of 37 CFR 1.52(e).

The petition is dismissed.

On 24 October, 2003, the application was filed.

On 29 June, 2004, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, stating that the application had been accorded a filing date of 24 October, 2003, and stating that the application is objected to because it contains a data file on CD-ROM/CD-R, however, the transmittal letter does not list for each compact disc, the machine format, the operating system compatibility, a list of files contained on the compact disc including their names, sizes in bytes, and dates of creation, plus any other special information that is necessary to identify, maintain, and interpret the information on the compact disc as required by 37 CFR 1.52(e). A statement listing the required information is required. Additionally, the discs are not identified in the paper portion of the specification with a listing of all of the files contained on the disc. When portions of an application are contained on a compact disc, the paper portion of the specification must identify the compact discs and list the files including name, file size and creation date on each of the compact discs. See 37 CFR 1.52(e). Applicants are required to amend the specification to identify each disc and the files contained on the disc including the file name, file size, and file creation date.

In response, on 30 August, 2004, the present petition was filed. Petitioners request waiver of the requirement of a listing of the files on the compact discs. Petitioners assert that a paper listing of the names, size in bytes, and dates of creation of all

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of the files contained on the compact discs would required several thousand pages of paper.

Suspension of the rules under 37 CFR 1.183 should be considered herein, suspension may be granted in an "extraordinary situation, when justice requires". The facts presented on the record do not establish an extraordinary situation. Petitioners have not established any special circumstances or equities that would require suspension of the rules in the interests of justice.

When a compact disc has been submitted as part of an application, one is required to list the files on the disc in the application and on the transmittal sheet.

Nevertheless, petitioners may wish to consider supplying a compact disc containing a file comprising the listing required by 37 CFR 1.52(e) in an ASCII format table. Petitioners would also need to supply a new transmittal letter and a preliminary amendment to the specification referencing the one (1) ASCII file containing the listing. As such, the petition is dismissed without prejudice to reconsideration pending submission thereof.

Petitioners are given TWO (2) MONTHS to file a compact disc, preliminary amendment, and supplemental application transmittal letter as stated above. **This time period is not extendable.**¹ Failure to file a timely reply will result in abandonment of the application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
 2011 South Clark Place
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 Crystal Plaza 2, Lobby, Room 1B03
 Arlington, VA 22202

¹37 CFR 1.181(f).

Petitioner should note that petitioner, and not the Office, is responsible for identifying and correcting any difference between the file list on the compact disc and the files actually on the compact disc.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



Douglas I. Wood
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Office of Petitions